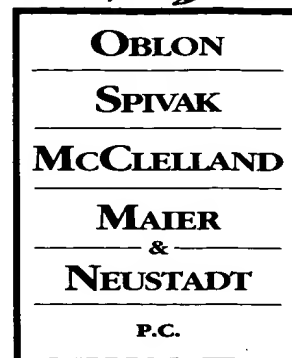




IFW 1616 AF #

Docket No.: 205731US0

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313



ATTORNEYS AT LAW

RICHARD L. TREANOR
(703) 412-6007

RTREANOR@OBLON.COM

JEFFREY B. MCINTYRE
(703) 413-3000

JMCINTYRE@OBLON.COM
*BAR OTHER THAN VIRGINIA

RE: Application Serial No.: 09/847,388

Applicants: Isabelle AFRIAT

Filing Date: May 3, 2001

For: USE OF FIBERS IN A CARE COMPOSITION OR A
MAKE-UP COMPOSITION TO MAKE THE SKIN
MATTE

Group Art Unit: 1616

Examiner: M. Haghighatian

SIR:

Attached hereto for filing are the following papers:

**Appeal Brief w/Appendix (In Triplicate);
Petition for Extension of Time (1 Month).**

Our credit card payment form in the amount of \$440.00 is attached covering any required fees. In the event any variance exists between the amount enclosed and the Patent Office charges for filing the above-noted documents, including any fees required under 37 C.F.R 1.136 for any necessary Extension of Time to make the filing of the attached documents timely, please charge or credit the difference to our Deposit Account No. 15-0030. Further, if these papers are not considered timely filed, then a petition is hereby made under 37 C.F.R. 1.136 for the necessary extension of time. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.

Norman F. Oblon

Richard L. Treanor

Registration No. 36,379

Jeffrey B. McIntyre

Registration No. 36,867

Customer Number

22850

(703) 413-3000 (phone)

(703) 413-2220 (fax)



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF: Isabelle AFRIAT

SERIAL NO: 09/847,388

GAU: 1616

FILED: May 3, 2001

EXAMINER: M. Haghighatian

FOR: USE OF FIBERS IN A CARE COMPOSITION OR A MAKE-UP COMPOSITION TO MAKE THE SKIN MATTE

REQUEST FOR EXTENSION OF TIME
UNDER 37 C.F.R. 1.136

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

It is hereby requested that a **one** month extension of time be granted to May 19, 2004 for

- ☐ filing a response to the Official Action dated:
- ☐ responding to the requirements in the Notice of Allowability dated:
- ☐ filing the Formal Drawings. The Issue Fee due has been timely filed.
- ☐ responding to the Notice to File Missing Parts of Application dated:
- ☐ filing a Notice of Appeal. A timely response to the final rejection, due has been filed.
- ☒ filing an Appeal Brief. A Notice of Appeal was filed on: February 19, 2004.
- ☐ Applicant claims small entity status. See 37 CFR 1.27. Therefore, the fee amount shown below is reduced by one-half.

The required fee of \$110.00 is enclosed herewith by credit card payment and any further charges may be made against the Attorney of Record's Deposit Account No. 15-0030. A duplicate copy of this sheet is enclosed.

Respectfully Submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.

Richard L. Treanor

Registration No. 36,379

Jeffrey B. McIntyre

Registration No. 36,867

04/26/2004 SDIRETA1 00000082 09847388

02 FC:1251

110.00 DP

Customer Number

22850

Tel. (703) 413-3000
Fax. (703) 413-2220
(OSMMN 05/03)

205731US0



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF: :

Isabelle AFRIAT : EXAMINER: M. Haghighatian

SERIAL NO.: 09/847,388 :

FILED: MAY 3, 2001 : GROUP ART UNIT: 1616

FOR: USE OF FIBERS IN A CARE COMPOSITION OR A MAKE-UP
COMPOSITION TO MAKE THE SKIN MATTE

APPEAL BRIEF

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

Appellant submits this brief in response to the Final Rejection dated August 19, 2003.

REAL PARTY IN INTEREST

The real party in interest herein is L'Oréal S.A. of Paris, France.

RELATED APPEALS AND INTERFERENCES

To the best of Appellant's knowledge, there are no other appeals or interferences which will directly affect or be directly affected by, or have a bearing on, the Board's decision in this appeal.

04/28/2004 3DIRETRI 00000082 09847388

01 FC:140E

330.00 0P

STATUS OF CLAIMS

Claims 1, 3-20, 35, 36 and 43-47 are pending.

STATUS OF AMENDMENTS

All amendments and remarks filed in this case have been entered and considered.

SUMMARY OF INVENTION

The invention relates to cosmetic compositions containing fibers and at least one active agent for treating greasy skin. (Specification at page 8, lines 19-22). In the invention composition, the active agent for treating greasy skin is chosen from a group of specific active agents. (Specification at page 8, line 22 through page 9, line 10). Also, the invention composition preferably has a covering index of greater than 0.1. (Specification at page 3, lines 13-15). The invention composition can be used to make skin complexion matte, make skin smooth and uniform, and/or fade out skin relief defects. (Specification at page 2, lines 23-24).

ISSUE

1. Whether The Pending Claims Are Obvious Over Castro in combination with Sebillotte-Arnaud.

GROUPING OF CLAIMS

The claims do not stand or fall together. Each claim stands individually, and in the argument section provided below Appellant explains why the claims are each separately patentable, one from the other.

ARGUMENT

The claims require, in a single composition, the presence of (1) fibers and (2) at least one active agent for treating greasy skin chosen from a specific group of active agents.

Castro does not disclose the claimed active agents for treating greasy skin. Sebillotte-Arnaud does not disclose compositions containing fibers. Thus, neither of the cited references, by themselves, contains a sufficient disclosure upon which a § 103 rejection could be based.

To compensate for the cited references' critical deficiencies, the Examiner has attempted to combine their disclosures to cobble together a § 103 rejection. However, such combination of the cited references is based upon hindsight reconstruction and, thus, is improper. It is only using the present application as a roadmap that the Examiner was able to find the motivation to combine fibers with at least one of the claimed active agents for treating greasy skin with the expectation that a stable, useful composition would result.

The Examiner's combination of Sebillotte-Arnaud's active agents with Castro's compositions is exactly the type of combination which Sebillotte-Arnaud had found to be problematic and which Sebillotte-Arnaud was trying to avoid. Thus, not only is this combination of references improper because it would render the references unsuitable for their intended purposes (see, MPEP § 2143.01), but it is also improper because Sebillotte-Arnaud teaches away from it.

Castro's fibers are present in an oil carrier. (Col. 4, line 19 et seq.). Moreover, Castro generically suggests adding oil-soluble active agents to his compositions, but not water-soluble active agents. (Col. 6, line 37). Thus, Castro discloses compositions (for example, emulsions) in which fibers and "active agents" (if present) are in the oil phase or an oil carrier.

Sebillotte-Arnaud states that the purpose of his invention is to provide a stable active agent-containing composition. Sebillotte-Arnaud notes that problems exist with conventional active agent-containing compositions such as emulsions, stating that "it is often difficult, indeed even impossible, to incorporate certain active agents such as kojic acid, caffeic acid, salicylic acid ..." into conventional cosmetic compositions. (Col. 1, lines 25-34). Sebillotte-Arnaud's solution to this problem is a gel composition containing a hydrophilic medium or carrier, not a conventional oil-containing composition such as an emulsion. (See, abstract). These active agent-containing gel compositions are described as being stable.

Given that Sebillotte-Arnaud found that his active agents were stable in a gel containing a hydrophilic carrier but were not stable in other types of compositions, one skilled in the art would not have been motivated to use such active agents in a composition which did not possess a hydrophilic carrier because no expectation would have existed that the resulting active agent-containing composition would be stable. In other words, one skilled in the art would not have been motivated to use Sebillotte-Arnaud's active agents in a composition containing an oil carrier because no expectation would have existed that these active agents would have been stable in such a composition. Thus, one skilled in the art

Application No. 09/847,388
Response to Final Rejection dated August 19, 2003

would not have been motivated to combine Sebillotte-Arnaud's active agents with Castro's oil-containing compositions.

Because no motivation would have existed to combine Sebillotte-Arnaud with Castro, the §103 rejection is improper.

In the Final Rejection (dated August 19, 2003) and the Advisory Action (dated March 17, 2004) in this case, the Examiner asserted that (1) the motivation/suggestion to combine Sebillotte-Arnaud's active agents and Castro's compositions comes from Castro's desire to control oily skin; (2) Castro relates to any type of composition, not just emulsions; and (3) Sebillotte-Arnaud was cited as merely supporting art to show that the named active agents are known in the art. Appellant's arguments above address each of the points raised by the Examiner and/or renders them moot.

Castro's merely desiring to control oily skin or generally stating that any type of composition will suffice is completely insufficient to overcome Sebillotte-Arnaud's teachings that his active agents should be in a hydrophilic medium. No motivation exists to combine Sebillotte-Arnaud's active agents with Castro's compositions. In this regard, Sebillotte-Arnaud is critical to the rejection, as it is the only evidence applied disclosing the claimed active agents. Sebillotte-Arnaud cannot be used "selectively" – it must be taken as a whole for what it teaches. As shown above, this reference teaches away from the claimed combination.

In view of the above, Appellant respectfully submits that the present claims are in condition for allowance, and that the pending rejection should be REVERSED.

Each dependent claim similarly points out and describes a patentable invention neither disclosed nor suggested by the applied prior art. These claims themselves are separately patentable.

Claim 3 is a composition claim further specifying the amount of active agent present. Neither Castro nor Sebillotte-Arnaud teaches or suggests compositions containing fibers and at least one active agent for treating greasy skin having this specific amount of active agent present, or any benefits resulting from such compositions.

Claim 4 is a composition claim which further requires that the fibers have a length ranging from 1 μm to 10 mm. Nowhere does Castro or Sebillotte-Arnaud describe or allude to this additional characteristic of the claimed fibers as being significant, nor do Castro or Sebillotte-Arnaud describe or suggest any benefits resulting from the use of such fibers in compositions containing fibers and at least one active agent for treating greasy skin.

Claim 5 is a composition claim further specifying the fibers' cross-section. Nowhere does Castro or Sebillotte-Arnaud describe or allude to this additional characteristic of the claimed fibers as being important, nor do Castro or Sebillotte-Arnaud describe or suggest any benefits resulting from the use of such fibers in compositions containing fibers and at least one active agent for treating greasy skin.

Claim 6 is a composition claim further specifying the fibers' cross-section, length and diameter. Nowhere does Castro or Sebillotte-Arnaud describe or allude to these additional characteristics of the claimed fibers as being important, nor do Castro or Sebillotte-Arnaud describe or suggest any benefits resulting from the use of such fibers in compositions containing fibers and at least one active agent for treating greasy skin.

Claim 7 is a composition claim further requiring a specified fiber to be present.

Nowhere does Castro or Sebillotte-Arnaud describe or allude to this particular type of fiber as being significant, nor do Castro or Sebillotte-Arnaud describe or suggest any benefits resulting from the use of such fibers in compositions containing fibers and at least one active agent for treating greasy skin.

Claim 8 is a composition claim further requiring a specified fiber (polyamide, poly(p-phenylene terphthalamide, cotton, or mixtures thereof) to be present. Nowhere does Castro or Sebillotte-Arnaud describe or allude to this particular type of fiber as being significant, nor do Castro or Sebillotte-Arnaud describe or suggest any benefits resulting from the use of such fibers in compositions containing fibers and at least one active agent for treating greasy skin.

Claim 9 is a composition claim further specifying the amount of fiber present.

Neither Castro or Sebillotte-Arnaud teaches or suggests compositions containing fibers and at least one active agent for treating greasy skin having this specific amount of fiber present, or any benefits resulting from such compositions.

Claim 10 is a composition claim further specifying the fibers' yarn count. Nowhere does Castro or Sebillotte-Arnaud describe or allude to this additional characteristic of the claimed fibers as being important, nor do Castro or Sebillotte-Arnaud describe or suggest any benefits resulting from the use of such fibers in compositions containing fibers and at least one active agent for treating greasy skin.

Claim 11 is a composition claim further requiring a coated fiber to be present.

Nowhere does Castro or Sebillotte-Arnaud describe or allude to this particular type of fiber as being significant, nor do Castro or Sebillotte-Arnaud describe or suggest any benefits

resulting from the use of such fibers in compositions containing fibers and at least one active agent for treating greasy skin.

Claim 12 is a composition claim further specifying that the composition be an emulsion. Neither Castro or Sebillotte-Arnaud teaches or suggests emulsions having both fibers and the claimed active agents for treating greasy skin, or any benefits resulting from such emulsions.

Claims 13, 35 and 36, each separately patentable, are composition claims further specifying the composition's covering index. Nowhere does Castro or Sebillotte-Arnaud describe or allude to this additional characteristic of compositions containing fibers and at least one active agent for treating greasy skin as being important, nor do Castro or Sebillotte-Arnaud describe or suggest any benefits resulting from the use of such compositions.

Claim 14 is a composition claim further specifying the presence of a physiologically acceptable medium. Nowhere does Castro or Sebillotte-Arnaud describe or allude to this additional characteristic of compositions containing fibers and at least one active agent for treating greasy skin as being important, nor do Castro or Sebillotte-Arnaud describe or suggest any benefits resulting from the use of such compositions.

Claim 15 is a composition claim further requiring the composition to be in the form of a cast product. Nowhere does Castro or Sebillotte-Arnaud describe or allude to this additional characteristic of the claimed compositions as being important, nor do Castro or Sebillotte-Arnaud describe or suggest any benefits resulting from the use of such compositions.

Claim 16 is a method claim requiring fibers and the claimed active agents for treating greasy skin to be combined in the same composition. Neither Castro nor Sebillotte-Arnaud describe or allude to such methods.

Claims 17-20, 43, 46 and 47, each separately patentable, require the use of compositions containing fibers and at least one of the claimed active agents for treating skin in a specific manner. Neither Castro nor Sebillotte-Arnaud describe or allude to such methods.

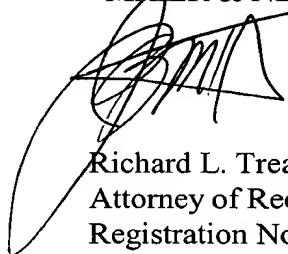
Claims 44 and 45, each separately patentable, require the specified use of compositions which contain fibers and at least one of the claimed active agents for treating greasy skin and which also have a specified covering index. Neither Castro nor Sebillotte-Arnaud describe or allude to such methods.

Application No. 09/847,388
Response to Final Rejection dated August 19, 2003

Accordingly, in view of the above remarks and reasons explaining the patentable distinctness of the presently appealed claims over the applied prior art, Appellant requests that the Examiner's rejections all be REVERSED.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.

A handwritten signature in black ink, appearing to be 'R. Treanor', is written over the printed name and title of Richard L. Treanor.

Richard L. Treanor
Attorney of Record
Registration No. 36,379

Jeffrey B. McIntyre
Registration No. 36,867

Customer Number

22850

Tel #: (703) 413-3000
Fax #: (703) 413-2220

APPENDIX

1. (Previously Presented): A cosmetic, skincare or make-up composition comprising fibers and at least one active agent for treating greasy skin, wherein the at least one active agent is selected from the group consisting of β -lactam derivatives; quinolone derivatives; ciprofloxacin; norfloxacin; tetracycline and its salts; erythromycin and its salts; amikacin and its salts; 2,4,4'-trichloro-2'-hydroxydiphenyl ether; 3,4,4'-trichlorocarbanilide; phenoxypropanol; phenoxyisopropanol; doxycycline and its salts; capreomycin and its salts; chlortetracycline and its salts; oxytetracycline and its salts; clindamycin and its salts; ethambutol and its salts; hexamidine isethionate; metronidazole and its salts; pentamidine and its salts; gentamicin and its salts; kanamycin and its salts; lineomycin and its salts; methacycline and its salts; methenamine and its salts; minocycline and its salts; neomycin and its salts; netilmicin and its salts; paromomycin and its salts; streptomycin and its salts; tobramycin and its salts; miconazole and its salts; amantadine salts; para-chloro-meta-xyleneol; nystatin; tolnaftate; 3-hydroxybenzoic acid and its salts; 4-hydroxybenzoic acid and its salts; 2-hydroxybutanoic acid and its salts; 2-hydroxypentanoic acid and its salts; 2-hydroxyhexanoic acid and its salts; phytic acid and its salts; N-acetyl-L-cysteine acid and its salts; lipoic acid and its salts; azelaic acid and its salts; arachidonic acid and its salts; ibuprofen; naproxen; hydrocortisone; acetaminophen; resorcinol; octopirox; lidocaine hydrochloride; clotrimazole; 10-hydroxy-2-decanoic acid and its salts; zinc gluconate; plant extracts from the ericacea family; sulphur-rich plant extracts; and mixtures thereof.

2. (Canceled).

3. (Original): The composition according to Claim 1, wherein the amount of the at least one active agent ranges from 0.0001% to 30% by weight relative to the total weight of the composition.

4. (Original): The composition according to Claim 1, wherein each of the fibers has a length in a range from 1 μm to 10 mm.

5. (Original): The composition according to Claim 1, wherein each of the fibers has a cross section that fits within a circle having a diameter in a range from 1 nm to 100 μm .

6. (Original): The composition according to Claim 1, wherein each of the fibers has a length L; a cross section that fits within a circle of diameter D; and a shape factor, given by L/D, that ranges from 5 to 150.

7. (Original): The composition according to Claim 1, wherein the fibers are selected from the group consisting of silk, cotton, wool or flax fibers; cellulose fibers extracted from wood, plants or algae; polyamide fibers; modified cellulose fibers; poly-phenyleneterephthalamide fibers; acrylic, polyolefin, glass, silica, aramid, carbon or TEFLON® fibers; insoluble collagen fibers; polyester, polyvinyl chloride, polyvinylidene chloride, polyvinyl alcohol, polyacrylonitrile, chitosan, polyurethane or polyethylene phthalate fibers; fibers formed from a mixture of polymers; resorbable synthetic fibers; and mixtures thereof.

8. (Original): The composition according to Claim 1, wherein the fibers are selected from the group consisting of polyamide fibers, poly-p-phenyleneterephthalamide fibers, cotton fibers, and mixtures thereof.

9. (Original): The composition according to Claim 1, wherein the fibers are present in an amount ranging from 0.1% to 30% by weight relative to the total weight of the composition.

10. (Original): The composition according to Claim 1, wherein the fibers have a yarn

count ranging from 0.15 to 30 denier.

11. (Original): The composition according to Claim 1, wherein the fibers are coated fibers.

12. (Original): The composition according to Claim 1, wherein the composition is an emulsion.

13. (Original): The composition according to Claim 1, wherein the composition has a covering index of greater than 0.1.

14. (Previously Presented): The composition according to Claim 1, wherein the composition is in a physiologically acceptable medium.

15. (Original): The composition according to Claim 1, wherein the composition is in the form of a cast product.

16. (Original): A method of making a cosmetic, skincare or make-up composition, the method comprising

mixing fibers and at least one active agent for treating greasy skin; and

forming the composition of Claim 1.

17. (Original): A method of using a cosmetic, skincare or make-up composition, the method comprising applying the composition of Claim 1 to skin.

18. (Original): A method of using a cosmetic, skincare or make-up composition, the method comprising

applying the composition of Claim 1 to skin; and

making the complexion of the skin at least one of matte, smooth and uniform, or fading out skin relief defects in the skin.

19. (Original): A method of using a cosmetic, skincare or make-up composition, the method comprising

applying the composition of Claim 10 to skin; and

making the complexion of the skin at least one of matte, smooth and uniform, or fading out skin relief defects in the skin.

20. (Original): A method of using a cosmetic, skincare or make-up composition, the method comprising

applying the composition of Claim 14 to skin; and

making the complexion of the skin at least one of matte, smooth and uniform, or fading out skin relief defects in the skin.

21-34 (Canceled).

35. (Previously Presented): The composition of Claim 13, wherein the covering index of the composition ranges from 0.1 to 0.5.

36. (Previously Presented): The composition of Claim 13, wherein the covering index of the composition ranges from 0.13 to 0.4.

37-42 (Canceled).

43. (Previously Presented): A method of fading out skin relief defects in skin comprising applying to the composition of Claim 1 to the skin.

44. (Previously Presented): The method of Claim 43, wherein the composition has a covering index ranging from 0.1 to 0.5.

45. (Previously Presented): The method of Claim 43, wherein the composition has a covering index ranging from 0.13 to 0.4.

46. (Previously Presented): A method for treating greasy skin, comprising applying the composition of claim 1 to greasy skin in an amount sufficient to provide a matte effect.

47. (Previously Presented): A method for controlling the greasy appearance of skin, comprising applying the composition of claim 1 to skin in need thereof.